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| MICHAEL CHAN | | | COLBERT, ELLA | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 09/848,003 | HALEY ET AL. |
| Examiner | Art Unit | |
| Ella Colbert | 3694 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 July 2007.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-6 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-6 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. ____.
3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
5) Notice of Informal Patent Application
6) Other: ____.

DETAILED ACTION

1. Claims 1-6 and 22-31 are pending. Claims 1-6 were examined in the prior office action in an Election by Original Presentation and newly added claims 22-31 were withdrawn by the Examiner because they were drawn to a different invention than claims 1-6 and this is in response to the communication filed 7/23/07 entered as Response After Non-Final Rejection.
2. The objection to the specification has been overcome by Applicants' amendment to the specification and is hereby withdrawn.
3. The objection to the abstract has been overcome by Applicants' amendment to the abstract and is hereby withdrawn.
4. The objection to the drawings is hereby maintained as set forth here below.
5. The objection to claim 1 has been overcome by Applicants' amendment to claim 1 and is hereby withdrawn.
6. The Election by Original Presentation is hereby maintained and proper due to the number of added distinct independent claims claiming different inventions creating an undue burden on the Examiner when giving the claims a proper examination and searching in different classes and subclasses.
7. The 35 USC 112 rejections are withdrawn in part as set forth here below.

Election By Original Presentation

8. Newly submitted claims 22-31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 23-31 are directed to relying on the authorization to execute a transaction without obtaining

authorization directly from a remote party and a dispenser for dispensing currency, tickets, coupons, or a token or circuit for use in the electronic device carried by a customer in connection with a transaction. Claims 1-6 are directed to receiving a transaction authorization request from the device and receiving a requested transaction from the users portable electronic device and fulfilling the requested transaction without the terminal preparing an authorization request, and the user's portable device making the authorization request to a remote party then transmitting the authorization received in response to the authorization request to a communication port.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-31 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 4, reference sign "54" and Figure 8, reference character(s) "40" and "60". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as

either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because Figure 8, reference character "42" has been used to designate both "IrDAport" and "communication port" and reference character "60" has been used to designate both "IR port" and "port". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “device” which is considered indefinite in the claim language because the “device” could be any “device” even though the preamble recites “A self-service terminal”. Applicants’ should consider changing the word “device to “user’s portable device”. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). There is nothing in the claim limitations that would lead one to know that the claim limitations are a self-service terminal that is being claimed.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over (EPO 933 733 A2) Kwan in view of (US 6,305,603) Grunbok et al, hereafter Grunbok.

As per claim 1. Kwan discloses, A self-service terminal comprising:
a communication port for interfacing with a user's portable electronic device and for

receiving a transaction authorization therefrom (Page 2, col. 2 [0009], Page 3, col. 4 [0013], and Figure 1). Kwan failed to disclose, means for receiving a requested transaction from a user's portable electronic device and for fulfilling the requested transaction without the terminal preparing an authorization request, wherein the user's portable device makes the authorization request of a remote party, and transmits the authorization received in response to the authorization request to the communication port . Grunbok, discloses means for receiving a requested transaction from a user's portable electronic device and for fulfilling the requested transaction without the terminal preparing an authorization request, wherein the user's portable device makes the authorization request of a remote party, and transmits the authorization received in response to the authorization request to the communication port (col. 3, line 66-col. 4, line 35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate in Kwan the teachings of Grunbok because such an incorporation would allow Kwan to have a faster and more efficient means to transmit an authorization request to a self-service terminal communication port.

As per claim 2. Kwan discloses A self-service terminal according to claim 1, further comprising (i) a dispenser for dispensing items, and (ii) means for cooperating with the dispenser to dispense an item to fulfill the requested transaction without the terminal preparing an authorization request (Page 3, col. 4 [0016] –Page 4, col. 5, line 14).

As per claim 3. Kwan discloses, A self-service terminal according to claim 1, further comprising (i) a storage area for receiving an item inserted by a user, and (ii)

means for cooperating with the storage area to receive an item from a user as part of the requested transaction without the terminal preparing an authorization request (Page 3, col. 3 [0012]-col. 4 [0015] and Page 5 [0023]).

As per claim 4. Kwan discloses A terminal according to claim 1, wherein the communication port comprises a wireless communication port (Page 4, col. 5 [0017]-col. 6 [0020]).

As per claim 5. Kwan discloses A terminal according to claim 1, wherein the communication port comprises a physical cradle into which the user's portable electronic device couples (Page 3, col. 4 [0016] –Page 4,col. 5, line 14).

As per claim 6. Kwan discloses, A terminal according to claim 1, further comprising means for storing each transaction authorization for proving that a transaction has been executed (Page 5, col. 7 [0025] –col. 8, line 39).

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the Examiner.

Response to Arguments

15. Applicants' arguments with respect to claims 1-6 and 22-31 have been considered but are not persuasive.

Issue no. 1: Applicants' argue: The assertion is contrary to general legal principles in the legal system, a "constructive" election is assumed to be made based on conduct of the party when the party fails to make an express election. That is, if a party behaves as though an election were made, the conclusion be proper that the party intended to make the election but forgot to do so and the concept does not apply here because the facts do not support and are not consistent with any intent by Applicants' to withdraw the claims in question have been considered but are not persuasive.

Response: An Election By Original Presentation is given in US application practice when the added claims are very diverse from the originally presented claims.

Applicants' new claims must parallel the originally presented claims in order for an Election By Original Presentation to be withdrawn. Newly added claims cannot be considered when they are so diverse from the original independent claim.

Claim 22 for example to parallel claim 1 should recite (a) a communication port for interfacing with a user's portable electronic device and for receiving a transaction authorization from the device with no telecommunication links to a financial network (b) means for (i) receiving a requested transaction form a user's portable electronic device carried by a customer for fulfilling the requested transaction without the terminal preparing an authorization request, wherein ...". Applicant's need to complete the remaining claim limitations because it is not the duty of the Examiner to write Applicant's claims. The Examiner's duty is to suggest, form rejections as necessary, search the

inventive concept, and try to place the application and the claims in condition for allowance with the cooperation of the Applicant(s) and their representative. It takes the cooperation of both the Examiner and Applicant(s) representative to achieve the goal of an allowance (patent).

Issue no. 2: Applicants' Argue: The claimed “[transmitting of] authorization received in response to the authorization request to the communication port” of the SST is not found in the cited passage in Grunbok and even if the references are combined this recitation is not found. MPEP 2143.03 states: To establish a *prima facie* obviousness ... all of the claim limitations must be taught or suggested by the prior art has been considered but is not persuasive. Response: Applicant is referred to the court case *Sakraida v. AGPro, Inc.* 189 USPQ, 449, 425 US273 (1976). There was no new element or new function. It was a mere use of common sense by one skilled in the art to select and combine known elements with no new function, i.e., a predictable result. Thus, the combination of Kwan and Grunbok et al achieved a predictable result which is a mere use of common sense by one of skill in the art to combine the teachings of Kwan and Grunbok et al. A *prima facie* case of obviousness has been established.

Conclusion: The Examiner is entitled to give limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be “given the broadest reasonable interpretation consistent with the specification.” Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

It is assumed that every reference relies to some extent on the knowledge of persons skilled in the art to complement that which is disclosed therein. Further, the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference/references. In other words, the person having ordinary skill in the art has a level of knowledge apart from the content of the references. *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of obviousness is established “from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.” *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Also see MPEP 2144 entitled “Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103: RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART – RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT.”

Inquiries

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Wednesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 11, 2007



ELLA COLBERT
PRIMARY EXAMINER